

# Office Action Summary

Application No.

10/033302

Applicant(s)

Hiltschuk et al

Examiner

J. Shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on February 23, 2004
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-50 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21 and 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is indefinite because the exact ranges claimed are unclear, due to the recitation of preferred ranges. The claim will be interpreted as requiring the non-preferred range. Claims 28-32 are indefinite as it is unclear how the treatment volume size limits the structure of the device.

Claims 1-5, 7, 9-14, 16-21, 23, 24, 26-31, 37, 39, 40, 43-49 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tankovich et al.

Tankovich et al teach a method and device as claimed see Figures 16A, 16B, and 23; column 16 line 20 to column 42 line 30; and column 58 line 14 to column 67 line 28. The volume of the treated portions can be made any described percentage of the entire volume by appropriate definition of the volume.

Claims 1 and 6-13, 15-18, 27-34, 36-39, and 41-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Eppstein et al.

See Figure 1 and column 16, line 42 to column 17, line 56; column 22, Example 5; and column 43, Example 28 herein U.S. Patent 4, 775,364 teaches the formation of lines.

Claims 49 and 50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nanaumi.

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Claims 1, 22, 27, 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haskin et al in combination with Tankovich et al. Haskin et al teach a method such as claimed except focusing the beam. Tankovich et al teach the use of controlling depth by controlling wavelength. It would have been obvious to the artisan of ordinary skill to employ a wavelength control rather than the needle depth control in the method and device of Haskin et al, since this would reduce the chance of infection by leaving the skin intact, official notice of which is hereby taken, thus producing a method and device such as claimed.

Claims 1, 6-8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanaumi in combination with Tankovich et al. Nanaumi teaches a method such as claimed (see figure 6 and column 1 lines 8-15), except for producing multiple faci. Tankovich et al teach concentrating the applied laser radiation and the coagulation of blood vessels with the concentrated radiation. It would have been obvious to the artisan of ordinary skill to employ the concentrating step of Tankovich in the method of Nanumi, since this would allow coagulation by thermal diffusion, leaving the surface tissue less affected, thus producing a method such as claimed.

Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

May 18, 2004